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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/364,638	07/30/1999	EIJI KAWAI	450127-02126	9709

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FROMMER LAWRENCE & HAUG
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NEW YORK, NY 10151

EXAMINER

PEYTON, TAMMARA R

ART UNIT PAPER NUMBER

2182

DATE MAILED: 10/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/364,638	KAWAI, EIJI	
	Examiner	Art Unit	
	Tammara R Peyton	2182	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 45-84 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 45-84 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.


Fritz Fleming
PRIMARY EXAMINER
GROUP 2100

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 45-84 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Hsu, patent number 5,785,598.

2. As per claims 45 and 55, *Hsu* teaches an information processing apparatus

(Fig.2) comprising:

- a processor (CPU, 11, Fig.2) for executing a booting program to start up said information apparatus; and
- a data store (ROM, 21, Fig.2) for storing first data,
- wherein said processor selectively uses said first data stored in said data storage or second data (ROM, 22, Fig. 2) stored in another data storage according to said booting program to start up said information processing apparatus, said other data storage being capable of data communication

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with said information processing apparatus. (Abstract, cols. 2, lines 14-col. 5, lines 1-37)

3. *Hsu* teaches wherein said processor selectively executes using either a first data store, from an existing game cartridge, (200, Figs. 1, 2) or a second data store, from add-on card (300, Fig.2) according to said booting control program to start up said information processing apparatus. (col. 4, lines 6-16) It would have been obvious to one of ordinary skill at the time the invention was made that *Hsu's* teaches a booting sequence that implements a software routine to load a boot program for starting up said information processing apparatus from either the first data store or the second data store. *Hsu* also teaches wherein said other data storage is capable of data communication with said information processing apparatus.

4. As per claims 51 and 61, *Hsu* teaches information processing apparatus (Fig.2) comprising:

- a processor (CPU, 11, Fig.2) for executing a booting program to start up said information apparatus; and
- a communication unit (obvious) for data communication with a plurality of data storages for storing data, at least one of said data storages being capable of data communication with said information processing apparatus,

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- wherein said processor selectively uses said data stored in said plurality of data storages according to said booting program to start up said information processing apparatus. (Abstract, cols. 2, lines 14-col. 5, lines 1-37)

5. As per claim 65-84 *Hsu* teaches a method of starting up an information processing apparatus, with a recording medium removably inserted therein, comprising the steps of:

- transmitting boot data, to be executed according to a boot sequence by an information processing apparatus which executes a program to process data, stored in a recording medium (smart card, 300b, Fig. 3b) that is removably inserted in the information processing apparatus to the information processing apparatus; and
- booting the information processing apparatus according to the booting sequence based on said boot data transmitted from said recording medium.

5. As per claims 46-49, 52, 54, and 58, *Hsu* teaches wherein the first data storage includes at least one of image data and sound data but does not expressly teach wherein the other data storage for storing said second data is a recording medium removably connected to said information processing apparatus also includes image and sound data. *Hsu*'s game console (50) includes an audio outlet (via 13, Fig. 2) and a video outlet (via 15, Fig. 2) for outputting sound and image data for an inserted video

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game cartridge. It is well known in the art at the time the invention was made that video game cartridge's include sound and image programs that are used in accordance with a game console's audio and video outlets. *Hsu* teaches wherein the second data storage includes additional image programs for a video game cartridge related to the first data storage wherein the first data storage includes video game data for the related video game cartridge, therefore, one of ordinary skilled in the art would readily recognize that the second data storage includes additional programs including at least one image data and sound data related to the first data storage that will be outputted via the game console's audio and video outlets.

6. As per claims 50, 53, 60, and 63, *Hsu* teaches wherein the other data storage is a portable electronic device (Smart card, 300b, Fig. 3b)

7. As per claims 56, 62, and 64, *Hsu* teaches wherein said first and second data are image data and displaying an image of the selected image data on a display according to said booting program in starting up said information processing apparatus.

8. As per claim 57, *Hsu* teaches wherein the other data storage is a recording medium removably connected to said information processing apparatus.

9. As per claim 59, *Hsu* teaches a method wherein an image of said first data is displayed on a display (television set, 18) in starting up said information processing

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apparatus when said recording medium is not connected to said information processing apparatus, and an image of said second data is displayed on said display in starting up said information processing apparatus when said recording medium is connected to said information processing apparatus.

Response to Applicant's arguments

Applicant argues that Examiner pointed to Hsu's BIOS ROM for the booting program. Examiner directed applicant to the wrong passage in Hsu, however, the Hsu rejection still stands based on the following grounds of rejections. *Hsu* teaches a operating booting sequence for the information processing apparatus (video game console) wherein a booting program is read from either a first data store (21) or a second data store (22). (Fig. 7) As to applicant arguments that *Hsu* does not teach wherein selection of image data or sound data is used in the booting process Examiner disagrees with applicant. *Hsu* teaches the use of a video game cartridge and it is well known in the art that a video game cartridge includes image data and sound data. *Hsu* teaches a first video game cartridge having a first data store and a second video game cartridge or smart card having a second data store, wherein both data stores includes a booting program and would also include image and sound data that would be used in accordance with the information processing apparatus' (video game console) audio and video outlets for display to user via television set, 18. During the booting sequence of the information processing apparatus data from the first or second data store is read by the information processing apparatus and image and sound data from the first or

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second data store is used for display depending upon with data store (first or second) is used for the booting process. (cols. 2, lines 14-col. 5, lines 1-37)

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tammara Peyton whose telephone number is (703) 306-5508. The examiner can normally be reached between 6:30 - 4:00 from Monday to Thursday, (I am off every first Friday), and 6:30-3:00 every second Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Gaffin, can be reached on (703) 308-3301. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3718. Any inquiry of a general nature of relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Mailed responses to this action should be sent to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231.

Faxes for Official/formal (After Final) communications or for informal or draft communications (please label "PROPOSED" or "DRAFT" or "OFFICIAL") sent to:

(703) 872-9306

Hand-delivered responses should be brought to:

USTPO, 2011 South Clark Place, Customer Window
Crystal Plaza Two, Lobby Room 1B03, Arlington, VA, 22202 Crystal Park II, 2121.

Tammara Peyton

October 6, 2004


FRITZ FLEMING
PRIMARY EXAMINER
GROUP 2100